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1636#

Practitioner's Docket No. NEB-199-C

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Nancy Craig, Elisabeth Raleigh and Fiona Stewart

Application No.: 10/024,809

Group No.: 1636

Filed: 12/19/2001

Examiner: Lambertson

For: Gain of Function Mutation in ATP-Dependent Transposition Proteins

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

AMENDMENT, REQUEST AND FEE TO DELETE AND/OR  
ADD TO ORIGINAL ERRONEOUSLY NAMED OR NOT NAMED  
INVENTOR(S) IN—NONPROVISIONAL APPLICATION—DECLARATION  
(37 C.F.R. § 1.48(a))

1. This amendment and request is to correct the incorrect original naming of inventor(s) in the declarations under 37 C.F.R. § 1.48(a) as set forth and filed on December 19, 2001 and February 5, 2003.

2. Addition and/or Deletion of Inventor(s)

Add the following previously unnamed person(s) as inventor(s) of this application: Elisabeth Raleigh and Fiona Stewart

3. Attachments

CERTIFICATION UNDER 37 C.F.R. §§ 1.8(a) and 1.10\*

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Express Mail certification is optional.)

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37 C.F.R. § 1.8(a)

X with sufficient postage as first class mail.

37 C.F.R. § 1.10\*

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facsimile transmitted to the Patent and Trademark Office, (703) \_\_\_\_\_ - \_\_\_\_\_

  
Signature

Date: April 21, 2004

Leslie Goldberg

(type or print name of person certifying)

\* Only the date of filing ( ' 1.6) will be the date used in a patent term adjustment calculation, although the date on any certificate of mailing or transmission under ' 1.8 continues to be taken into account in determining timeliness. See ' 1.703(f). Consider "Express Mail Post Office to Addressee" ( ' 1.10) or facsimile transmission ( ' 1.6(d)) for the reply to be accorded the earliest possible filing date for patent term adjustment calculations.

Amendment, Request and Fee to Delete and/or Add to Original Erroneously Named or Not Named Inventor(s)  
in Declaration (37 C.F.R. § 1.48(a))--page 1 of 2

Attached is:

- (a) A statement from each person being added as an inventor that the error in inventorship occurred without deceptive intention on his or her part. 37 C.F.R. § 1.48(a)(1).
- (b) A declaration by each of the actual inventor(s) as required by 37 C.F.R. § 1.63 (or as permitted by §§ 1.42, 1.43, OR 1.47). 37 C.F.R. § 1.48(a)(2).
- (c) Written consent of the assignee. 37 C.F.R. § 1.48(a)(4).
- (d) Statements Establishing Right of Assignee to Take Action.
- (e) An explanation of the facts, including the ownership of all the claim(s) being claimed in this application, including the ownership of all the claim(s) at the time the last claimed invention was made (Declaration of Inventorship and Common Ownership of Claims in Application).
- (f) Two recordation cover sheets, together with attached assignments.

4. Fee Payment (37 C.F.R. § 1.17(i))

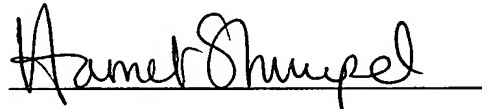
The fee required by 37 C.F.R. § 1.17(i) is paid as follows:

Attached is a check in the amount of \$210.00, covering the petition fee and two requests for recordation of assignments.

Charge any additional fees required by this paper or credit any overpayment to deposit account number 14-0740.

A duplicate of this paper is attached.

Date: April 21, 2004



Harriet M. Strimpel  
Registration No. 37,008  
New England Biolabs, Inc.  
32 Tozer Road  
Beverly, MA 01915  
(978) 927-5054, ext. 373  
Customer No. 28986

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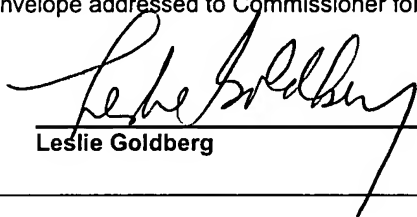
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**CERTIFICATION UNDER 37 C.F.R. §§ 1.8(a) and 1.10\***

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Date: April 21, 2004


  
\_\_\_\_\_  
Leslie Goldberg

**STATEMENT UNDER 37 C.F.R. 1.48 (1)  
THAT ERROR OF OMISSION IN INVENTORSHIP OCCURRED  
WITHOUT DECEPTIVE INTENT**

We declare that the addition of Elisabeth Raleigh and Fiona Stewart as inventors in the above-referenced application is necessitated by the newly submitted claims filed August 19, 2003, that the inventorship as originally filed was appropriate for the claims filed prior to the amendment and that there was no deceptive intent in the presentation of inventorship as originally filed.

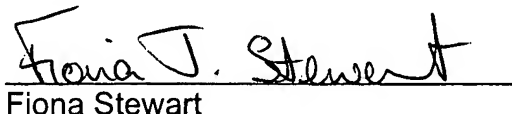
Date:

4/20/04

  
\_\_\_\_\_  
Elisabeth Raleigh

Date:

4/16/04

  
\_\_\_\_\_  
Fiona Stewart

New England Biolabs, Inc.  
32 Tozer Road  
Beverly, MA 01915



**DECLARATION  
AND POWER OF ATTORNEY  
Original Application**

Attorney Docket No. NEB-199-C  
35789/241825(5789-3A)

As a below named inventor, I hereby declare that:

My residence, post address and citizenship are as stated below next to my name

I believe that I am the original, first and sole inventor (in only one name is listed at 201 below) or an original, first and joint inventor (if plural names are listed at 201-203 below) of the subject matter which is claimed and which a patent is sought on the invention entitled:

GAIN OF FUNCTION MUTATIONS IN ATP-DEPENDENT TRANSPOSITION PROTENS

which is described and claimed in:

[ ] the attached specification or ☒ the specification in Application Serial No. 10/024,809 filed 12/19/01  
(for declaration not accompanying application)

And was amended on \_\_\_\_\_  
if applicable

I hereby state that I have reviewed and understand the contents of the above identified specification, including the claims, as amended by any amendments referred to above. I acknowledge the duty to disclose information which is material to the examination of this application in accordance with Title 37, Code of Federal Regulations, §1.56(a).

I hereby claim foreign priority benefits under Title 35, United States Code, §119 of any foreign application(s) for patent or inventor's certificate listed below and have also identified below any foreign application for patent or inventor's certificate listed below and have also identified below any foreign application for patent or inventor's certificate having a filing date before that of the application on which priority is claimed:

FOREIGN APPLICATION(S) IF ANY, FILED WITHIN 12 MONTHS PRIOR TO THE FILING DATE OF THIS APPLICATION			
COUNTRY	APPLICATION	DATE OF FILING (day, month, year)	PRIORITY CLAIMED UNDER 35 U.S.C. 119
			YES NO
			YES NO
ALL FOREIGN APPLICATION(S) IF ANY, FILED MORE THAN 12 MONTHS PRIOR TO THE FILING DATE OF THIS APPLICATION			
COUNTRY	APPLICATION	(day, month, year)	PRIORITY CLAIMED UNDER 35 U.S.C. 119

I hereby claim the benefit under Title 35, United States Code §120 of any United States application(s) listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in the prior United States application in the manner provided by the first paragraph of Title 35, United States Code §112, I acknowledge the duty to disclose material information as defined in Title 37, Code of Federal Regulations, §1.56(a) which occurred between the filing date of the prior application and the national or PCT international filing date of this application:

Application Serial No.	Filing Date	Status (Patented, Pending, Abandoned)
09/027,169	February 20, 1998	Patented
60/037,955	February 20, 1997	Abandoned

DECLARATION  
AND POWER OF ATTORNEY  
PAGE 2 OF 3

**POWER OF ATTORNEY:**

As a named inventor, I hereby appoint the following attorney with full powers of association, substitution and revocation to prosecute this application and transact all business in the Patent and Trademark Office connected therewith:

Gregory D. Williams      Harriet M. Strimpel  
(Registration No. 30901)      (Registration No. 37008)

**SEND CORRESPONDENCE TO:**

Gregory D. Williams  
General Counsel  
New England Biolabs, Inc.  
32 Tozer Road  
Beverly, MA 01915

**DIRECT TELEPHONE CALLS TO:**

Harriet M. Strimpel  
Patent Counsel  
New England Biolabs, Inc.  
Tele: (978) 927-5054; Ext. 373  
Fax: (978) 927-1705

201	Full Name of Inventor	Last Name	First Name	Middle Name
	Residence & Citizenship	City	State/Foreign Country	Citizenship
	Post Office Address	Post Office Address	City/State/Country	Zip Code
202	Full Name of Inventor	Last Name	First Name	Middle Name
	Residence & Citizenship	City	State/Foreign Country	Citizenship
	Post Office Address	Post Office Address	City/State/Country	Zip Code
203	Full Name of Inventor	Last Name	First Name	Middle Name
	Residence & Citizenship	City	State/Foreign Country	Citizenship
	Post Office Address	Post Office Address	City/State/Country	Zip Code
204	Full Name of Inventor	Last Name	First Name	Middle Name
	Residence & Citizenship	City	State/Foreign Country	Citizenship
	Post Office Address	Post Office Address	City/State/Country	Zip Code
205	Full Name of Inventor	Last Name	First Name	Middle Name
	Residence & Citizenship	City	State/Foreign Country	Citizenship
	Post Office Address	Post Office Address	City/State/Country	Zip Code

DECLARATION  
AND POWER OF ATTORNEY  
PAGE 3 OF 3

2	Full Name of Inventor	Last Name Craig	First Name Nancy	Middle Name
0	Residence & Citizenship	City Baltimore	State/Foreign Country Maryland	Citizenship USA
6	Post Office Address 850 South Bond St.	Post Office Address 1000 Fell Street, Apt. 222	City/State/Country Baltimore, MD	Zip Code 21231
2	Full Name of Inventor	Last Name Raleigh	First Name Elisabeth	Middle Name
0	Residence & Citizenship	City Somerville	State/Foreign Country Massachusetts	Citizenship USA
7	Post Office Address	Post Office Address 32 Barton Street	City/State/Country Somerville, MA	Zip Code 02144
2	Full Name of Inventor	Last Name Stewart	First Name Fiona	Middle Name
0	Residence & Citizenship	City Ipswich	State/Foreign Country Massachusetts	Citizenship United Kingdom
8	Post Office Address	Post Office Address 10 Oakwood Knoll Rd.	City/State/Country Ipswich, MA	Zip Code 01983
2	Full Name of Inventor	Last Name	First Name	Middle Name
0	Residence & Citizenship	City	State/Foreign Country	Citizenship
9	Post Office Address	Post Office Address	City/State/Country	Zip Code

I hereby further declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true and further that these statements were made with the knowledge that willful statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Signature of Inventor 201	Date
Signature of Inventor 202	Date
Signature of Inventor 203	Date
Signature of Inventor 204	Date
Signature of Inventor 205	Date
Signature of Inventor 206	Date
Signature of Inventor 207	Date
Signature of Inventor 208 Fiona Stewart	Date
Signature of Inventor 209	Date

← Nancy Craig

Sept. 9, 2003  
16 Sept 03  
9/15/03



Docket No.: NEB-199-C

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANTS: Nancy Craig EXAMINER: Lambertson

SERIAL NO.: 10/024,809 GROUP: 1636

FILED: December 19, 2001

FOR: Gain of Function Mutation in ATP Dependent  
Transposition proteins

Commissioner of Patents  
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Alexandria, VA 22313-1450

**Written consent of the Assignee of the original named inventor  
according to 1.48 (c) (5)**

Assignee: John Hopkins University agrees that Drs. Lise Raleigh and Fiona Stewart be added as co-inventors with Dr Craig of present claims 26-31 in the present filed application. It is further agreed that the ownership interest of the newly added co-inventors be assigned to New England Biolabs Inc.

Keith Baker, Director of Licensing and  
Technology Development

10/13/03

Dated

611 E 968 351  
APR 23 2004  
PATENT & TRADEMARK OFFICE

Practitioner's Docket No. NEB-199-C

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Craig et al.

Application No.: 10/024,809

Group No.: 1636

Filed: December 19, 2001

Examiner:

For: Gain of Function Mutation in ATP-Dependent Transposition Proteins

_____	Issue Date: _____
Patent*:	
_____	Issue Date: _____
Reexamination No.:	
_____	Issue Date: _____
Reissue:	

\* NOTE: Insert name(s) of inventor(s) and title for patent.

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

STATEMENT UNDER 37 C.F.R.3.73(b)—  
ESTABLISHING RIGHT OF ASSIGNEE TO TAKE ACTION

**CERTIFICATION UNDER 37 C.F.R. §§ 1.8(a) and 1.10\***

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37 C.F.R. § 1.8(a)

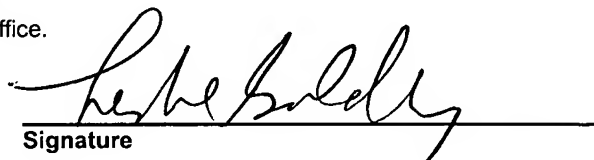
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37 C.F.R. § 1.10\*

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TRANSMISSION

☐ transmitted by facsimile to the Patent and Trademark Office.

  
Signature

Date: April 21, 2004

Leslie Goldberg

(type or print name of person certifying)

**\*WARNING:** Each paper or fee filed by Express Mail must have the number of the Express Mail mailing label placed thereon prior to mailing. 37 C.F.R. § 1.10(b).

"Since the filing of correspondence under § 1.10 without the Express Mail mailing label thereon is an oversight that can be avoided by the exercise of reasonable care, requests for waiver of this requirement will not be granted on petition." Notice of Oct. 24, 1996, 60 Fed. Reg. 56,439, at 56,442.



NOTE: 37 CFR 3.73(b) states: "When an assignee seeks to take action in a matter before the Office with respect to a patent application, . . . , patent, registration, or reexamination proceeding, the assignee must establish its ownership of the property to the satisfaction of the Commissioner. Ownership is established by submitting to the Office, in the Office file related to the matter in which action is sought to be taken, documentary evidence of a chain of title from the original owner to the assignee (e.g., copy of an executed assignment submitted for recording) or by specifying (e.g., reel and frame number) where such evidence is recorded in the Office. The submission establishing ownership must be signed by a party authorized to act on behalf of the assignee. Documents submitted to establish ownership may be required to be recorded as a condition to permitting the assignee to take action in a matter pending before the Office."

NOTE: "Section 3.73(b) is amended to remove the sentence requiring an assignee to specifically state that the evidentiary documents have been reviewed and to certify that title is in the assignee seeking to take action. The sentence is deemed to be unnecessary in view of the amendment to §§ 1.4(d) and 10.18." Notice of Oct. 10, 1997, 62 Fed. Reg. 53,131, at 53,174.

1. The assignee(s) of the entire right, title and interest hereby seek(s) to take action in the PTO in this matter.

#### IDENTIFICATION OF ASSIGNEE

2. Johns Hopkins University School of Medicine

Name of assignee

University

Type of assignee, e.g., corporation, partnership, university, government agency, etc.

#### PERSON AUTHORIZED TO SIGN

3. Keith Baker

(type name of person authorized to sign on behalf of assignee)

Director of Licensing and Technology Development

Title of person authorized to sign

NOTE: The Notice of April 30, 1993 (1150 O.G. 62-B4) points out

"The statement under 37 CFR 3.73(b) may be signed on behalf of the assignee in the following two manners if the assignee is an organization (e.g., corporation, partnership, university, government agency, etc.).

"(1) The statement may be signed by a person in the organization having apparent authority to sign on behalf of the organization. An officer (president, vice-president secretary, or treasurer) is presumed to have authority to sign on behalf of the organization. The signature of the chairman of the board of directors is acceptable, but not the signature of an individual director. A person having a title (manager, director, administrator, general counsel) that does not clearly set forth that person as an officer of the assignee is not presumed to be an officer of the assignee or to have authority to sign the statement on behalf of the assignee. A power of attorney from the inventors in an organization to a practitioner to prosecute a patent application does not make the practitioner an official of an assignee or empower the practitioner to sign the statement on behalf of the assignee.

"(2) The statement may be signed by any person, if the statement includes an averment that the person is empowered to sign the statement on behalf of the assignee and, if not signed by a registered practitioner, the statement must be in oath or declaration form. Where a statement does not include such an averment, and the person signing does not hold a position in the organization that would give rise to a presumption that the person is empowered to sign the statement on behalf of the assignee, evidence of the person's authority to sign will be required."

[Author's Note: The requirement for an oath or declaration for this statement by a person not a registered practitioner was rescinded by the rules effective December 1, 1997.]

(complete the following, if applicable)

☒ I, the person signing below, state that I am empowered to sign this statement on behalf of the assignee.

### BASIS OF ASSIGNEE'S INTEREST

Ownership by the assignee is established as follows:

A.

1. ☐ An assignment from the inventor(s) of the matter identified above, which was recorded in the PTO at  
Reel \_\_\_\_\_, Frame \_\_\_\_\_.
2. ☒ An assignment (document) separately being submitted for recordal herewith.

### AND/OR

B. ☐ A chain of title from the inventor(s) to the current assignee as shown below:

1. From: \_\_\_\_\_  
Name of inventor(s)  
To: \_\_\_\_\_  
Recorded in PTO:  
Reel \_\_\_\_\_, Frame \_\_\_\_\_
2. From: \_\_\_\_\_  
Name of inventor(s) or assignee  
To: \_\_\_\_\_  
Recorded in PTO:  
Reel \_\_\_\_\_, Frame \_\_\_\_\_
3. From: \_\_\_\_\_  
Name of inventor(s) or assignee  
To: \_\_\_\_\_  
Recorded in PTO:  
Reel \_\_\_\_\_, Frame \_\_\_\_\_

*(check item below, and add details, if applicable)*

- ☐ Additional documents in the chain of title are listed in the attached Supplemental Sheet.

### COPIES OF DOCUMENTS IN CHAIN OF TITLE

*(complete this item, if copies are being sent)*

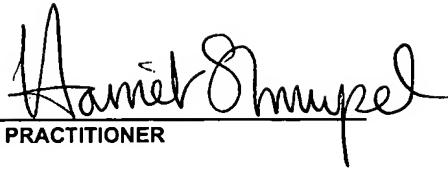
- ☒ Copies of the assignment(s) or other document(s) in the chain of title are attached as follows:

☒ A      ☐ 1      ☒ 2  
☐ B      ☐ 1      ☐ 2      ☐ 3

Reg. No.:37,008

Tel. No.: (978) 927-5054, ext. 373

Customer No.: 28986



SIGNATURE OF PRACTITIONER

Harriet M. Strimpel, D. Phil.

*(type or print name of practitioner)*

New England Biolabs, Inc.

P.O. Address

32 Tozer Road

Beverly, MA 01915



APPLICANTS: Nancy Craig                      EXAMINER: Lambertson

SERIAL NO.: 10/024,809      GROUP: 1636

FILED: December 19, 2001

FOR: Gain of Function Mutation in ATP Dependent Transposition proteins

Commissioner of Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

### Correction of Inventorship under 37C.F.R. § 1.48(c)

The current claims (new claims 26-31) submitted in a response dated 8/19/03 to a restriction request dated 5/20/03 require addition of two inventors: Lise Raleigh and Fiona Stewart to the present single named inventor-Nancy Craig.

Submitted herewith is the following:

(1) A request to correct the inventorship that sets forth the desired inventorship change as described above.

(2) A statement from each person being added as an inventor that the addition is necessitated by amendment of the claims and that the inventorship error occurred without deceptive intention on her part

(3) A declaration by the actual inventors as required by § 1.63

(4) A processing fee of \$130 set forth in § 1.17(i); and

(5) Written consent of the assignee.

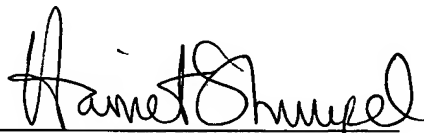
### **CONCLUSION**

For the reasons set forth above, Applicants respectfully submit that this case is in condition for immediate allowance. Early and favorable consideration leading to prompt issuance of this Application is earnestly solicited.

Should the Examiner wish to discuss any of the amendments and/or remarks made herein, the undersigned Attorney would appreciate the opportunity to do so..

Respectfully submitted,

NEW ENGLAND BIOLABS, INC.

A handwritten signature in black ink, appearing to read "Harriet Strimpel", written over a horizontal line.

Harriet M. Strimpel, D.Phil  
(Reg. No. 37008)  
Patent Counsel  
32 Tozer Road  
Beverly, Massachusetts 01915  
(978) 927-5054 X:373

Date: April 21, 2004